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## THE EXPENSIVE FUTILITY OF THE UNITED STATES TRADE-MARK STATUTE

EVERY lawyer of much experience knows the client who tip-toes into his office, closes the door carefully, and with a great show of secrecy announces that he has discovered or invented the best name for a soda cracker, a patent medicine, a soft drink, or what not, that human ingenuity ever conceived. He wants it protected before any one can steal it from him. He wants it "Copyrighted." This is the expression most commonly used. He seems to be under the impression that some incantation can be performed by means of which he will be able to secure to himself the exclusive use of his new name for crackers or whatever it may be. His lawyer is probably under some similar delusion and sets about to find a way to endow his client with his discovery, enormous secrecy being religiously maintained all the while. He too has a hazy notion that he can copyright something whereby his client can exclude the world—all of which is due to a very general ignorance of what a trade-mark is and how the right to one is acquired.

A trade mark is a means by which merchandise is identified. A copyright is the exclusive right to multiply copies of a published intellectual work. A trade-mark is purely utilitarian, its function is commercial, it may be the result of an accident, in any event it does not depend upon invention or discovery or intellectual creation and need not be original.<sup>1</sup> A work to be the subject matter of copyright must embody creative intellectuality and must be the result of the creative effort of the mind resulting in a work of literature, art, the drama or music.<sup>2</sup> Copyright is a statutory creation and the purpose is to encourage "learned men to write useful books," to reward genius by securing the fruits of it, to stimulate art and letters. The right to a trade-mark does not depend upon creation, or invention. A trade-mark is not a work of literature or art, its creator is not necessarily a genius; its primary function is not to please the ear or eye, or to give instruction, information or intellectual enjoyment, but to indicate in an unmistakable fashion who is the maker or seller of the merchandise to which it is attached; and finally the right to it is not statutory but is a common

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<sup>1</sup> Trade-Mark Cases, 100 U. S. 82.

<sup>2</sup> Trade-Mark Cases, 100 U. S. 82; *Mott Iron Works v. Clow*, 82 Fed. 318; *Lithographic Co. v. Sarony*, 111 U. S. 53, 58.

law right of great antiquity. It is not the creation of statute.<sup>3</sup> Historically, trade-marks are one of the oldest of human institutions. Probably it is the supposed analogy between trade-marks and copyrights that is the cause of the generally prevalent impression that the right to a trade-mark is dependent upon statute and can be secured only by compliance with statutory formalities and is evidenced by imposing documents embellished by red seals and red tape and beginning "To all to whom these presents shall come greeting." As a matter of fact the right to a trade-mark is created solely by priority of adoption and use and continuous occupancy of the market with goods bearing it.<sup>4</sup> It is an incident to a business, a symbol of good will, not an abstraction. The notion that a trade-mark is analogous to copyright was sufficiently deepseated to cause the first federal registration act to be based on that provision of the constitution which authorizes Congress to secure to authors and inventors for limited times the exclusive right to their respective writings and discoveries, and formed part of an act entitled "An act to revise, consolidate and amend the statutes relating to patents, trade-marks and copyrights."<sup>5</sup> This statute was declared unconstitutional on the ground that a trade-mark was neither a writing nor a discovery, and that such legislation could not be founded upon the constitutional power given to Congress to protect authors and inventors.<sup>6</sup> Then an act was passed under the commerce clause and treaty-making power permitting the registraton in the Patent Office of trade-marks used in commerce with foreign nations or with Indian tribes. In 1905<sup>7</sup> the present trade-mark act was passed permitting the registration in the Patent Office of trade-marks used in commerce among the several states, with foreign nations or with the Indian tribes. Its provisions are briefly as follows:

The owner of a trade-mark used in commerce with foreign nations, or among the several states, or with Indian tribes, may obtain registration by complying with certain prescribed require-

<sup>3</sup> *United States v. Braun*, 39 Fed. 775; *Sarrazin v. Irby*, 93 Fed. 624, 627; *Trade-Mark Cases*, 100 U. S. 82, 93; *Edison v. Thomas A. Edison Chem. Co.*, 123 Fed. 1013, 1014; *Carroll v. McIlvaine*, 171 Fed. 125, 129; *Brower v. Boulton*, 53 Fed. 389.

<sup>4</sup> *Listman Mill Co. v. Listman Milling Co.*, 88 Wis. 334, 340; *Johnson v. Schenck*, Fed. Cas. 7412; *Leidersworf v. Flint*, 8 Biss. 327, Fed. Cas. 8219; *Schneider v. Williams*, 44 N. J. Eq. 391, 394, 14 Atl. 812, 814; *Kathreiner's Malzkaffee Fabriken Mit Beschraenkter Haftung v. Pastor Kneipp Med. Co.*, 82 Fed. 321, 325; *McLean v. Fleming*, 96 U. S. 245, 254.

<sup>5</sup> Act of July 8, 1870, Ch. 230, 16 Statutes at Large 210, August 14, 1876, Ch. 274, 19 Statutes at Large. 141, R. S. U. S. 4937, 4947.

<sup>6</sup> *Trade-Mark Cases*, 100 U. S. 82.

<sup>7</sup> Act of Feb. 20, 1905. Amended May 4, 1906, March 2, 1907, Feb. 18, 1909, Feb. 18, 1911, Jan. 8, 1913, Fed. Stat. Annotated Vol. 10, p. 408. Supplement, 1909, pp. 673-676. U. S. Compiled Statutes 1907 Supplement, 1908, Patent Office Circular Mar. 1, 1913.

ments. No mark by which the goods of the owner of the mark may be distinguished from other goods shall be refused registration as a trade-mark on account of the nature of such mark unless (a) is immoral or scandalous; (b) consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State, or municipality, or of any foreign nation, or the name or emblem of certain societies, provided that trade-marks which are identical with a registered or known trademark owned and in use by another and appropriated to merchandise of the same descriptive properties, or which so nearly resemble a registered or known trademark owned and in use by another and appropriated to merchandise of the same descriptive properties as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers shall not be registered. No mark which consists merely in the name of an individual, firm, corporation or association not distinctively cast or in association with a portrait is registrable, neither are marks which consist merely in words or devices which are descriptive of the goods upon which they are used or of the character or quality of such goods, or are merely a geographical name or term. No portrait of a living individual may be registered except by consent of such individual evidenced by an instrument in writing, "and provided further that nothing herein shall prevent the registration of any mark used by the applicant or his predecessors, or by those from whom title to the mark is derived in commerce with foreign nations or among the several States, or with Indian tribes, which was in actual and exclusive use as a trade-mark of the applicant or his predecessors from whom he derived title for 10 years next preceding February 20, 1905."

Upon the filing of an application for registration and payment of the fees, the Commissioner of Patents is required to cause an examination to be made, and if after such examination it shall appear that the applicant is entitled to have his trade-mark registered under the provision of the Act, the Commissioner shall cause the mark to be published at least once in the Official Gazette of the Patent Office. Any person who believes he would be damaged by the registration of a mark may oppose the same by filing notice of opposition, stating the grounds therefor in the Patent Office within thirty days after the publication of the mark sought to be registered. If no notice of opposition is filed within such time, the Commissioner shall issue a certificate of registration. If on examination an application is refused, the Commissioner shall notify the applicant, giving him his reasons therefor. In all cases where notice of opposition has been filed the Commissioner of Patents shall notify

the applicant thereof and the grounds therefor. Whenever an application is made for the registration of a trade-mark which is substantially identical with a trade-mark appropriated to goods of the same descriptive properties, for which a certificate of registration has been previously issued to another or for registration of which another has previously made application, or which so nearly resembles such trade-mark, or a known trade-mark owned and used by another, as, in the opinion of the Commissioner, to be likely to be mistaken therefor by the public, he may declare that an interference exists as to such trade-mark, and in every case of interference or opposition to registration he shall direct the Examiner in charge of interferences to determine the question of the right of registration to such trade-mark, and of the sufficiency of objections to registration in such manner and upon such notice to those interested as the Commissioner may by rules prescribe. The Commissioner may refuse to register the mark against the registration of which objection is filed, or may refuse to register both of two interfering marks, or may register the mark, as a trade-mark, for the person first to adopt and use the mark if otherwise entitled to register the same. Whenever any person shall deem himself injured by the registration of a trade-mark in the Patent Office he may at any time apply to the Commissioner of Patents to cancel such registration. The Commissioner shall refer such application to the Examiner in charge of interferences, who is empowered to hear and determine this question and who shall give notice thereof to the registrant. If it appear after a hearing before the Examiner that the registrant was not entitled to the use of the mark at the date of his application for registration thereof, or that the mark is not used by the registrant, or has been abandoned, and the Examiner shall so decide, the Commissioner shall cancel the registration. Appeals are provided for the decision of the Examiner of Trade-Marks and the Examiner of Interferences to the Commissioner of Patents, and if an applicant for registration of a trade-mark, or a party to an interference as to a trade-mark, or a party who has filed opposition to the registration of a trade-mark, or a party to an application for the cancellation of the registration of a trade-mark is dissatisfied with the decision of the Commissioner of Patents, he may appeal to the Court of Appeals of the District of Columbia.

Every registered trade-mark and every mark for the registration of which application has been made is assignable in connection with the good will of the business in which the mark is used. Such assignment must be an instrument in writing and duly acknowledged according to the laws of the country or state in which it is executed.

Such assignment is void as against any subsequent purchaser for a valuable consideration, without notice, unless it is recorded in the Patent Office within three months from its date.

A certificate of registration (with certain exceptions) remains in force for twenty years and may be renewed from time to time for like periods. Certificates of registration are *prima facie* evidence of ownership of the mark registered. "Any person who shall without the consent of the owner thereof reproduce, counterfeit, copy, or colorably imitate any such trade-mark and affix the same to merchandise of substantially the same descriptive properties as those set forth in the registration or to labels, signs, prints, packages, wrappers, or receptacles intended to be used upon or in connection with the sale of merchandise of substantially the same descriptive properties as those set forth in such registration, and shall use, or shall have used, such reproduction, counterfeit, copy or colorable imitation in commerce among the several states or with a foreign nation, or with the Indian tribes, shall be liable to an action for damages therefor at the suit of the owner thereof; and whenever in any such action a verdict is rendered for the plaintiff, the court may enter judgment therein for any sum above the amount found by the verdict as the actual damages, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs."

"That the several courts vested with jurisdiction of cases arising under the present act shall have power to grant injunctions, according to the course and principles of equity to prevent the violation of any right of the owner of a registered trade-mark, on such terms as the court may deem reasonable; and upon a decree being rendered in any such case for wrongful use of a trade-mark the complainant shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby, and the court shall assess the same or cause the same to be assessed under its direction." Courts of equity are given the same power to increase damages, as is given for increasing damages found by verdict in actions of law; and in assessing profits the plaintiff is required to prove defendant's sale only; defendant must prove all elements of cost which are claimed.

The Federal Courts are given jurisdiction of all suits at law or in equity respecting registered trade-marks without regard to the amount in controversy. The successful plaintiff may have delivered up for destruction all infringing marks, labels and the like.

Whenever there are interfering registered trade-marks, any person interested in any one of them may have relief against the inter-

fering registrant, and all persons interested under him, by suit in equity against the registrant; and the court, on notice to adverse parties and other due proceedings had according to the course of equity, may adjudge and declare either of the registrations void in whole or in part according to the interest of the parties in the trade-mark, and may order the certificate of registration to be delivered up to the Commissioner of Patents for cancellation.

It is further provided that nothing in the act shall prevent, lessen, impeach or avoid any remedy at law or in equity which any party aggrieved by any wrongful use of any trade-mark might have had if the act had not been passed.

There are other provisions but they are not pertinent to the present discussion.

It is manifest from the foregoing brief summary of it that this statute is a slovenly piece of legislation, characterized by awkward phraseology, bad grammar and involved sentences. Its draftsmen had a talent for obscurity amounting to genius.

Taking up a few of the things which are moderately clear from the act, the first thing which strikes the reader is in the first section. Registration may be effected by the *owner* of a trade-mark, used in interstate or foreign commerce or commerce with the Indian tribes.

Who is the owner of a trade-mark? There is nothing in the act on the subject, so the common law definition must be sought, and here we find that the owner of a trade-mark is he who was the first to adopt and use it.<sup>8</sup> The next word in the act except a preposition and an article is "trade-mark"; there is no definition given to this word so we must again go to the common law where we learn that a trade-mark is a word, letter, device or symbol or some combination of these used in connection with an article and either inherently or by association pointing distinctly to the origin or ownership of the article to which it is applied.<sup>9</sup> In short a trade-mark is the means by which manufacturers and merchants identify their manufactures and merchandise.<sup>10</sup> The trade-mark to be registrable must under the terms of the act already have been used in interstate or foreign commerce or commerce with Indian tribes.<sup>11</sup> It is therefore plain

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<sup>8</sup> See Cases in Note 4.

<sup>9</sup> *Lawrence Mfg. Co. v. Tennessee Co.*, 138 U. S. 537; *Elgin National Watch Co. v. Illinois Watch Case Co.*, 129 U. S. 665, 673; *McLean v. Fleming*, 96 U. S. 245; *Canal Co. v. Clark*, 80 U. S. 322.

<sup>10</sup> *Trade-Mark Cases*, 100 U. S. 82, 87.

<sup>11</sup> *A. B. Andrews Co. v. Puncture Proof Footwear Co.*, 168 Fed. 762; *Ryder v. Holt*, 128 U. S. 525; *Wrisley v. Rouse*, 90 Fed. 5; *Gravely v. Gravely*, 42 Fed. 265; *Warner v. Searle & Hereth*, 191 U. S. 195; *Schumacker v. Schwenke*, 26 Fed. 818; *Sarrazin v. Irby*, 93 Fed. 624; *Luyties v. Hollendeer*, 21 Fed. 281; *Glen Cove v. Ludeman*, 22 Fed. 823; See Cases collected in Note, p. 332, Vol. 7, *Federal Statutes Annotated*.

that the act does not create anything and is wholly unlike the patent and copyright statutes in this respect. It is then provided that certain marks shall not be registered and that nothing shall prevent the registration of any mark actually and exclusively used as a trade-mark by an applicant or his predecessor in interstate, foreign or Indian commerce for ten years next preceding February 20, 1905. This provision was adopted from the English act and was spoiled in the taking. In the English act the phraseology is understandable and a definite purpose was sought to be accomplished; to permit the registration of nontechnical trade-marks which had long been in use.<sup>12</sup> The mischievous and senseless insertion of the word "exclusive" in our statute effectually interferes with its efficiency and destroys the benefits which are made possible by the English act. It was first held that the word "exclusive" in our statute meant the right to exclude,<sup>13</sup> but later that it means exclusive in fact,—sole—and that any use by others than the applicant of the mark sought to be registered even in purely a descriptive sense, or even an infringing use prevents registration under this provision.<sup>14</sup> No one seems to know what this section of the act means or what are its results. The Courts are hopelessly at variance. Is it intended to create a trade-mark out of what is not and cannot be a trade-mark?

<sup>12</sup> "Provided that any special and distinctive word or words, letter, figure or combination of letters or figures or of letters and figures, used as a trade mark before the thirteenth day of August, one thousand eight hundred and seventy-five may be registered as a trade-mark under this part of this act." Sec. 64, Act of 1883. (Sebastian on Trade Marks, 4 Ed. p. 331.) The act of 5 Edw. VII C. 15, (1905) contains this language (§ 9): "Provided always that any special or distinctive word or words, letter, numeral, or combination of letters or numerals used as a trade mark by the applicant or his predecessors in business before the thirteenth day of August one thousand eight hundred and seventy-five, which has continued to be used (either in its original form or with additions or alterations not substantially affecting the identity of the same) down to the date of the application for registration shall be registrable as a trade mark under this Act." Kerley & Underhay, "The Trade Mark Act of 1905" p. 23.

For Constructions see: Kerley on Trade Marks, (2nd ed. 1901) p. 187; Re Hopkinson's Trade Mark, (1892) 2 Ch. 116, 9 R. P. C. 102, 107; Bodega Co. v. Owens, 6 R. P. C. 236, 241, 242; Reinhardt v. Spalding, 49 L. T. Ch. 57, 38 W. R. 300, Austen-Cartmell Digest 285; Campania General v. Rehder, 5 R. P. C. 61, 65.

<sup>13</sup> Ex Parte Cahn Belt & Co., 118 O. G. 1936, C. D. (1905) 422; Ex Parte Yale & Towne Mfg. Co., 127 O. G. 3641, C. D. (1907) 122; Beech Hill Distillery Co. v. Brown Forman Co., 128 O. G. 1293, C. D. (1907) 146; Worcester Brewing Corporation v. Reuter, 128 O. G. 1687, C. D. (1907) 151; Capewell Horse Nail Co. v. Mooney, 167 Fed. 575, 592.

<sup>14</sup> Worcester Brewing Corporation v. Reuter, 133 O. G. 1190, 30 App. D. C. 428; Wrigley v. Norris, 152 O. G. 488; In re Wright & Taylor, 148 O. G. 834; Duluth Superior Milling Co. v. Koper, 167 O. G. 245; Becker v. Gambrill, 179 O. G. 1111; Sears v. Brakeley, 178 O. G. 885, 180 O. G. 882; Gambrill v. Waggoner Gates Milling Co., 181 O. G. 821.

For other cases see Underwood Card Digest of Trade Mark Cases No. 2975, Century Digest, Title Trade Marks, Sec. 14, Decennial Digest, Sec. 10.



Several Federal Courts have held that it has that effect.<sup>15</sup> The Circuit Court of Appeals of the Second Circuit said yes in one appeal and no in a second appeal in the same case.<sup>16</sup> The Circuit Court of Appeals of the Seventh Circuit paid no attention to the registration of a sur-name under the provision.<sup>17</sup> The Circuit Court of Appeals of the English Circuit dismissed a registration of a personal name under this section of the statute by saying—"The bill set up a right to the word Knabe as a registered trade-mark. But the word being incapable of use as a trade-mark, the claim seems to have been abandoned at the trial and in this Court."<sup>18</sup> The District Court of the Southern District of New York held that a word, not a trade-mark because descriptive, registered under the so-called "ten year proviso," might be presumed to have acquired a secondary or identifying meaning as applied to the registrant's product.<sup>19</sup> It is evident that what Congress left uncertain the Courts have made incomprehensible.

Another singularly unhappy expression used at least twice in the act has given rise to much dispute and uncertainty.

It is provided that no mark shall be registered which so nearly resembles a registered or known mark owned and in use by another

<sup>15</sup> *Coco-Cola Co. v. Deacon Brown Bottling Co.*, 200 Fed. 105; *Coco-Cola Co. v. Nashville Syrup Co.*, 200 Fed. 153; *Coca-Cola Co. v. Nashville Syrup Co.*, 200 Fed. 157.

<sup>16</sup> *Thaddeus Davids Co. v. Davids*, 165 Fed. 927; *Thaddeus Davids Co. v. Davids*, 178 Fed. 801; *Thaddeus Davids Co. v. Davids*, 192 Fed. 915. Reversed in *Thaddeus Davids Co. v. Davids & Davids*, Supreme Court of U. S. 202 O. G. 952. Here the Supreme Court held that a corporation, which by virtue of actual and exclusive use is entitled to register a personal name under the Ten Year Proviso, becomes on due registration the owner of it as a trade mark and is entitled to be protected in its use as such and that where the complainant, who had registered the name "Davids" under § 5 of the Trade-Mark Act, placed that name prominently at the top of its labels and the defendants placed in the same position on their labels the name "C. L. Davids," and at the bottom of the labels, "Davids Manufacturing Company," held that the use of the name in this manner was in simulation of the complainant's mark and that such use would be enjoined, saying:

"The right to be protected against an unwarranted use of the registered mark has been made a statutory right, \* \* \* in view of this statutory right, it could not be considered necessary that the complainant in order to establish infringement should show wrongful intent in fact on the part of the defendant, or facts justifying the inference of such an intent. \* \* \* Having duly registered under the act, the complainant would be entitled to protection against any infringing use, \* \* \*"

In this case, while the name used by the defendants was their own, the court held that—

"It was not necessary that, in exercising the right to use their own name in trade, they should imitate the mark which the complainant used, and was entitled to use under the statute, as a designation of its wares \* \* \*"

The decree of the Circuit Court of Appeals was reversed and that of the Circuit Court affirmed. (190 Fed., 285).

For other cases see Underwood's Card Digest of Trade Mark Cases, No. 2975.

<sup>17</sup> *Borden's Condensed Milk Co. v. Borden's Ice Cream Co.*, 201 Fed. 510, 513.

<sup>18</sup> *Stix, Baer & Fuller Dry Goods Co. v. American Piano Co.*, 211 Fed. 271, 276.

<sup>19</sup> *American Lead Pencil Co. v. Gottlieb*, 181 Fed. 178.

and appropriated to merchandise of the *same descriptive properties*; in other words, infringing marks are not registrable, and in defining infringement the language used being "anyone who shall without the consent of the owner reproduce, counterfeit, copy or colorably imitate any such trade-mark and affix the same to merchandise of *substantially the same descriptive properties* as those set forth in the registration, \* \* \*" The phrase "*descriptive properties*" has been the trouble maker. A virtuoso in vagueness must have conceived it.<sup>20</sup> The rule accepted by the courts in declaring the common law was understandable enough. A defendant could not escape a charge of trade-mark infringement by contending that his goods upon which he used the complainant's trade-mark were not identical with the complainant's. The false representation which the courts aim to suppress is a false representation as to the commercial origin of merchandise, so where the goods of the parties are of such a character that from the use of the same mark on both, an ordinary buyer would be likely to assume that they emanated from the same producer, the use of the mark by the defendant on such goods is restrained because it is calculated to represent that his goods are of the complainant's manufacture, or connected in some way with the complainant,—that there is a false representation as to their origin. The use of the complainant's mark upon defendant's goods enables the defendant to profit by the complainant's reputation and unfairly to secure for his productions a credit and salability to which they are not entitled. As Judge COXE once remarked:<sup>21</sup>

"But it is urged that as the complainant did not manufacture tooth brushes at the time the defendants entered the field, it cannot be injured by the sale of tooth brushes by others. We do not think the conclusion follows. The complainant had acquired a reputation as the manufacturer of high grade toilet brushes; it certainly had a right to include tooth brushes at any time, and, when it did so, purchasers who were acquainted with the high character of its goods would quite likely purchase its tooth brushes, deeming its previous reputation a guaranty of excellence.

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The public is deceived by such conduct, the reputation of

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<sup>20</sup> This phrase was in the Act of 1870 (Sec. 4942, Rev. Stat. 16 Stat. at L. 211), in the act of 1876—(19 Stat. at Large, 141), and also in the Act of 1881 (Sec. 7) 21 Stat. at Large, 503), 7 Fed. Stat. Ann. p. 326-333). It was probably blindly copied from one into the others.

<sup>21</sup> Florence Manufacturing Co. v. Dowd, 178 Fed. 73. See also Mr. Justice Blatchford's discussion in Collins & Co. v. Oliver Ames & Co., 18 Fed. 561; Church v. Russ, 99 Fed. 276; Carroll v. Ertheiler, 1 Fed. 688.

the established manufacturer is injured if the goods represented to be his are of inferior quality, and he is hindered in entering a field which he has a right to enter at any time he sees fit.

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The argument in these cases is a simple one: Where the defendant has so dressed his goods that they may be mistaken for the goods of the complainant his motive in so doing is either honest or dishonest, if honest, he should stop voluntarily; and, if dishonest, he should be compelled to stop."

The trade-mark statute apparently attempts to improve upon this rule. The goods of the parties to an infringement suit concerning a registered trade-mark must be of "substantially the same descriptive properties."

When is merchandise of substantially the same descriptive properties? What are the descriptive properties of merchandise? The nearest synonym of properties is a attributes or, loosely, qualities or characteristics. Then what are *descriptive* attributes, or qualities or characteristics. If an imitated mark to infringe must be used upon goods of substantially the same qualities or characteristics, well and good, but why *descriptive* and why *descriptive properties* in one part of the act and *substantially the same descriptive* properties in another.

Possibly the whole thing was intended as a practical joke. Everybody has heard of jokers in statutes. Descriptive properties are well known in geometry, (but as far as I know nowhere else). As usually defined there, descriptive properties are properties or propositions which can be stated without introducing the idea of magnitude,—those which do not depend upon the particular system of measurement adopted. Thus two triangles are equal if a side and two angles of the one are equal to the corresponding side and angles of the other. Speaking geometrically, then, merchandise may be of the same descriptive properties if it can be conceived without reference to size. For example oatmeal and rolled oats are of the same descriptive properties in bulk but not in pound packages. The foregoing is foolish enough but it is hard sense compared with some of the decisions involving the phrase "descriptive properties."

In construing the sections of the trade-mark act containing these words—which, whatever its results, were probably not intended to be less liberal than the common law, the tribunals of the Patent Office and the Court of Appeals of the District of Columbia at first allowed and applied the common sense rule of the common law,

but later for some inexplicable reason there was a change, until it seemed to be held that two articles of merchandise were not of the same descriptive properties unless they are likely to be confused as commodities. That is oil paint is not of the same descriptive properties as water paint or kalsomine, because a purchaser who wants to buy oil paint is not likely to buy kalsomine thinking he is getting oil paint, and hence the owner of a trade-mark for oil paint cannot complain of its use by a competitor on kalsomine.<sup>22</sup>

To quote the language of the Court of Appeals in a recent case:<sup>23</sup>

"This is a statutory proceeding and we must of course be governed by the provisions of the statute relating thereto. \*  
\* \* \* Unless there are no distinguishing characteristics between the goods of the respective parties we have no authority to interfere.

\* \* \* \* \*

It requires altogether too great a stretch of the imagination to conclude that any one calling for breakfast food would accept salted codfish without knowing the difference."

\* \* \* \* \*

If this be the law it is legitimate for one to use as a trade mark for canned peaches, a name or device made famous by another as a brand for canned pears, because surely it is unlikely that a person wishing to buy peaches would buy pears thinking he was getting peaches.

Within the year there has been still another change until it appears now as if there is a reversion to the first rule—all of which does not clarify the legal situation or help lawyers advise their clients.<sup>23a</sup> Some of the decisions showing the varying and confusing holdings under this section are given in the note.<sup>24</sup>

<sup>22</sup> *Muralo Co. v. National Lead Co.* C. D. (1911), 324, 165 O. G. 475, 36 App. D. C. 541.

<sup>23</sup> *Educator Food Co. v. Sylvanus Smith & Co.*, 175 O. G. 268, 37 App. D. C. 107, C. D. (1912) 440.

<sup>23a</sup> A reversion to the old rule seems to be intimated in *Woven Steel Hose & Rubber Co. v. Keasbey & Matteson Co.*, 198 O. G. 495, and in *H. Wolf & Sons v. Lord & Taylor*, 202 O. G. 632, where the doctrine announced in *Educator Food Co. v. Sylvanus Smith & Co.* (note 23 above) seems to be repudiated though that case and other like it are not in terms overruled.

<sup>24</sup> In the following cases the marks were the same or so nearly alike that one may be assumed to infringe the other. The question presented was whether the goods of the parties on which the common mark was used were merchandise of the same "descriptive properties."

In *Ex Parte Crown Distilleries*, 98 O. G. 2590, C. D. (1902) 115, it was held that whiskey and fruit brandy are merchandise of the same descriptive properties.

In *Vanderbergh & Co. v. Belmont Distillery Co.*, 107 O. G. 2235, C. D. (1903) 496, it was held that whiskey and gin are not merchandise of the same descriptive properties, while in *Bowler v. Eager*, 148 O. G. 571, it was held that they are. In

*Vanderbergh v. Blankenheym v. Nolet*, 108 O. G. 563, C. D. (1904) 27, it was held that gin and Hollands are merchandise of the same descriptive properties; and so are cock-tails, and whiskey, rum, gin, brandy, cocktails and punch. In *Re Boston Wine Spirits Co.*, 189 O. G. 524. In *Frank v. MacWilliam*, 117 O. G. 1165, C. D. (1905) 262, it was held that suspenders and hose supporters are not merchandise of the same descriptive properties, while work shirts, flannel shirts, over-alls and trousers are. *Ex parte Ohio Garment Co.*, 153 O. G. 821;—as are collars, coats, trousers and vests and shirts and suitings, *Irish Industrial Assn. v. Barrett*, 186 O. G. 797. Timothy seed and clover seed held goods of the same descriptive properties in *Conklin & Son v. The Albert Dickinson Co.*, 122 O. G. 1398, C. D. (1906) 181,—as also are rugs and carpets. *Mc-Cleary v. Bigelow Carpet Co.*, 3 T. M. Rep. 110.

Bitters and ground roots and barks in packages with directions for making bitters, held goods of the same descriptive properties in *Schuster v. Muller*, 126 O. G. 2192, C. D. (1907) 455, 28 App. D. C. 409. Gasoline and vapor stoves and coal stoves held goods of the same descriptive properties in *American Stove Co. v. Detroit Works v. Barstow Stove Co.*, 134 O. G. 2245, 31 App. D. C. 304; while in *G. & J. Tire Co. v. G. J. G. Motor Car Co.*, 190 O. G. 550, it was held that tires and automobiles are not.

Ready Mixed Paints and Paste Paints held merchandise of the same descriptive properties in *John T. Lewis & Bros. Co. v. Phoenix Paint Varnish Co.*, 134 O. G. 1049, 139 O. G. 990; white lead and wood fillers are also, *Warren Paint Co. v. Reeve v. Davidson*, 148 O. G. 1345; while in *Muralo v. National Lead Co.*, 165 O. G. 475, white lead paint and kalsomine were held not to be. *Keystone Co. v. National Lead & Oil Co.*, 185 O. G. 832 holds that black filler and white lead and oxide of lead are.

Cocoa and coffee are merchandise of the same descriptive properties, *Walter Baker & Co. v. Harrison*, 138 O. G. 770; *Ex parte Austin Nichols & Co.*, 167 O. G. 981; while sweet chocolate and coffee are not, *Stollweck v. Lucerna Co.*, 184 O. G. 804.

Straight and blended whiskies are goods of the same descriptive properties, In *re Wright and Taylor*, 148 O. G. 834—as are beer and beerine, *Girst v. Strehlow*, 157 O. G. 999—and olive oil and cotton seed oil. *Ex parte Fortuna & Mayo*, 165 O. G. 473; beer and a malt beverage, *Ex parte Independent Breweries Co.*, 172 O. G. 833, 182 O. G. 251; Wood wool and paper wool, *Ex parte Seabury & Johnson*, 173 O. G. 865;—while breakfast foods and macaroni are not, *Quaker Oats Co. v. Mother's Macaroni Co.*, 198 O. G. 899.

A thick syrup containing malt and a malt tonic beverage are goods of the same descriptive properties, *Peter Schoenhofen Brewery Co. v. The Maltine Co.*, 134 O. G. 1805, 30 App. D. C. 340;—as are cigars and smoking and chewing tobacco, *Ex parte Penn. Tobacco Co.*, 144 O. G. 275; and saws, tools, files and hammers and hatchets, *Ex parte Bendley Hardware Co.*, 141 O. G. 285; while *Educator* crackers and breakfast foods are not of the same descriptive properties as *Educator* sardines, *Johnson Educator Food Co. v. Sylvanus Smith & Co.*, 175 O. G. 268.

Toilet soap and laundry soap, in *Ex parte Willard Chemical Co.*, 107 O. G. 1972, C. D. (1903) 490, are goods of the same descriptive properties. Laundry soap and saponified shampoo preparations, *Ex parte Goodrich Drug Co.*, 183 O. G. 783. Syrups for flavoring beverages and ginger ale, sarsaparilla, lemon and soda, *Ex parte Allgoever*, 183 O. G. 505; while it was held in *Hump Hairpin Co. v. DeLong Hook & Eye Co.*, 190 O. G. 1932, that *Hump Hairpins* were not of the same descriptive properties as *Hump Hooks and Eyes*. Though later in *H. Wolf & Sons v. Lord & Taylor*, 202 O. G. 632, hosiery and knitted and textile undershirts, drawers and union suits were held by the same court to be goods of the same descriptive properties as mens, womens and childrens stockings.

A liniment and a powder for the treatment of rheumatism, neuralgia and lumbago are goods of the same descriptive properties, *Ex parte Nicolaus*, 161 O. G. 268; as are family liniment and crude oil for skin diseases, *Ex parte Boving*, 159 O. G. 490; and bleached sheetings and linen fabrics, *Ex parte Beaumont Mfg. Co.*, 159 O. G. 491; and syrups and imitation flavoring, *Ex parte Price Flavoring Extract Co.*, 163 O. G. 728; Butter and oleomargarine, *Jelke v. Fleischl*, 176 O. G. 274, *Utrecht Export Co. v. Greindt*, 183 O. G. 784; cotton sheetings and blankets, and silk and cotton and silk

If the purpose of the law which has grown up dealing with unfair trading, whether by imitation of trade-marks or otherwise, is to secure to the honest trader the good will of his business and to protect it against the injurious assaults of fraudulent competitors, this statute designed as an aid in the enforcement of that law is singularly inefficient. And this inefficiency of which the foregoing are examples is directly due to the slatternly draftsmanship of the act and its awkward phraseology.

It will be observed that three proceedings are provided for within the Patent Office: oppositions, interferences and cancellations. A notice of opposition may be filed by anyone who deems himself injured by an unissued published application for registration and must be filed within thirty days from publication of the mark in the Official Gazette; a cancellation proceeding may be instituted at any time by one who would be damaged by a mark which has been registered; and interferences are declared by the Patent Office, sometimes at the request of a party and sometimes of its own motion between a registration and an application, or two or more pending applications to register the same or similar trade marks. The procedure in general is the same in all of these proceedings. In opposition and cancellation cases, more or less formal pleadings are filed. A notice of opposition or petition for cancellation is first exhibited, setting out the grounds for the proceeding; the applicant or registrant, as the case may be, then answers or is defaulted, and issue is finally joined. In interference cases the Patent Office formulates the issue in a word or two, usually a notation on the bottom of the paper declaring the interference in some such way as this "Issue the word Quaker for rolled oats" or more vaguely still "Issue the marks claimed for the goods specified." The procedure in all these cases follows the equity practice in Federal Courts, except that all testimony is taken by deposition, commonly before a Notary Public who has neither the power nor usually the inclination to limit the examination. The records therefore are frequently scandalous in their prolixity and are full of incompetent testimony, supposition and surmise, long-winded objections, stump speeches and altercations between counsel, and in general are monuments to the evils of unsupervised testimony, and

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mixed piece goods, *Jackson v. Rogers*, 174 O. G. 1025, *Ex parte Rosenthal*, 181 O. G. 541—Canned fish and canned salmon, *Ex parte Sims*, 179 O. G. 285; canned fruits and vegetables and pickles, *Kidd v. Reuter*, 2 T. M. Rep. 257; Sawing machines and saws, *Ex parte Crescent Machine Co.*, 2 T. M. Rep. 257. While in *Consumers Co. v. Hydrox Chemical Co.*, 182 O. G. 722, *Hydrox Peroxide of Hydrogen* and *Hydrox distilled water* were held not of the same descriptive properties.

See Underwood's Card Digest of Trade Mark Cases, Nos. 395, 395a.

since no costs can be taxed against anybody in a Patent Office proceeding, nobody is or can be disciplined and the worst that happens is an occasional mild reproof in the decision of some long suffering official who is compelled to wade through hundreds of pages of printed gossip in search of a little evidence. Of course this sort of thing is expensive,—lawyers must be paid, notaries public and stenographers have their living to earn. The record must be printed, briefs written and printed, and the cases finally argued before the Examiner of Interferences. The losing party may appeal first to the Commissioner of Patents and then to the Court of Appeals of the District of Columbia.

A vigorously prosecuted and defended Patent Office proceeding may easily last for years and cost thousands. *Jarndyce v. Jarndyce* moved swiftly in comparison.

The conditions are not the fault of the officials of the Patent Office; a more efficient and conscientious set of public servants it would be difficult to find. It is the statute itself that is responsible.

And what is it all about? The right to register a trade-mark. And when the trade-mark is registered what then? Then the statute provides that the person in whose name the trade-mark is registered is *prima facie* the owner, which liberally translated means that he claims to be the owner and it looks as if he might be. Not that he is.<sup>25</sup> The defeated party to the proceeding can go right ahead using the mark which the Patent Office has held that the other party has the better right to, and if the victor wishes to put a stop to this use he must sue for an injunction in a court, and then before he can succeed he will probably have to duplicate the taking of testimony and argue the thing all over again before a judge who is quite likely to pay no attention to the decision of the Patent Office. Finally it may happen that some third party was the first to adopt and use the mark and that the registrant has not even a color of right to it. And since registration creates only a presumption of ownership, it can always be rebutted and a showing of prior use is of course enough to do it.<sup>26</sup>

The principal objection to Patent Office trade-mark proceedings

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<sup>25</sup> *Hennessy v. Braunschweiger*, 89 Fed. 664, 668. Hawley, J.: "It follows from the views expressed that the protection afforded to trade-marks, under the common law, by the United States courts, is ample, and that registration under the act of 1881 is of but little, if any, value, except for the purpose of creating a permanent record of the date of adoption and use of the trade-mark, or in cases where it is necessary to give jurisdiction to the United States courts."

Although there are cases which hold that registration is not even public notice. *Brennan v. Emery-Bird-Thayer Dry Goods Co.*, 99 Fed. 971.

<sup>26</sup> *Carroll v. McIlvaine*, 171 Fed. 125. Hough, J. (128): "The complainant gives undue weight to the series of registrations above set forth. Property right in a trade-

is that they get nowhere. They are imitation law suits, sham battles making a deal of noise and smoke but where no one is hurt. But the ammunition costs as much as if the fight were in earnest.

It may be that some day a case will get to the Supreme Court and that court will construe the act in a way to make the registration statute a virile thing, but as it is now interpreted it is an expensive and misleading farce.<sup>27</sup>

The present trade-mark act is, in my judgment, wrong in principle. As long as the common law prevails in this country the right to a trade-mark can depend only upon priority of adoption followed by open, notorious and continuous use. The important inquiry to be made when the adoption of a new mark is under con-

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mark exists at common law and is independent of the statutes regulating registration. Under the present trade-mark act a certificate of registration is prima facie evidence of ownership; but this evidence may be contradicted in court, and the apparent right of the registering party shown not to exist. Registration cannot confer a title to a trade-mark, if some other individual has acquired a prior right by adoption and use; nor can it vest a title in the registrant as against another's common-law title. *Glen Cove Mfg. Co. v. Ludeling*, (C. C.) 22 Fed. 823; *La Croix v. May*, (C. C.) 15 Fed. 236; *Ohio Baking Co. v. National Biscuit Co.*, 127 Fed. 116, 62 C. C. A. 116. The fundamental inquiry, therefore, in this case (as in most others relating to property in trade-marks), is: To which of the contending parties should judicial protection be granted upon the ground that he first produced or brought into the market an article of consumption that has found favor with the public, and first affixed thereto some name or symbol which serves to distinguish it as his? \* \* \* The owner of a trade-mark has no estate in the trade-mark as such, nor does registration confer upon him any monopoly. His position bears no resemblance to that of a patentee. He is entitled to legal protection for his trade-mark only because by granting the same the courts protect the business designated or indicated to the public mind by the trade-mark." *La Croix v. May*, 15 Fed. 236; *Luyties v. Hollander*, 30 Fed. 632.

*Glen Cove Co. v. Ludeling*, 22 Fed. 823, 826, *Wallace, J.*, "The defendant insists that his certificate of registry is a decision of the commissioner of patents that he is entitled to use the word 'Maizharina,' in connection with his picture, as a trade-mark, notwithstanding the complainant's trade-mark is the word 'Maizena,' which is a judicial determination, and is conclusive as between the parties. The sufficient answer to this proposition is that the act of Congress makes the registration of a trade-mark only prima facie evidence of ownership. Section 7. The inquiry is therefore always open as to the validity of the title to a trade-mark evidenced by the registration. The registration could not confer a title to the trade-mark upon the complainant if some other corporation or individual had acquired a prior right by adoption and use; nor could it vest defendant with a title as against the complainant's common-law title. In this view, the only office of a registration is to confer jurisdiction upon the court to protect a trade-mark when the proprietor has obtained the statutory evidence of title, and the only function of the commissioner of patents is to determine whether an applicant has a presumptive right to the trade-mark. An order is granted for an injunction, in conformity with this opinion."

*Hennessy v. Braunschweiger*, 89 Fed. 664. *Hawley, J.* (668): "It is only necessary to add that under the provisions of the act of 1881 the registration of a trade-mark is only prima facie evidence of ownership, and is not conclusive or binding upon the courts as to the right of a party to its exclusive use. *Browne, Trade-Marks*, Sec. 339; *Manufacturing Co. v. Ludeling*, 22 Fed. 824, 826."

<sup>27</sup> In *Davids v. Davids* (April 27, 1914) 202 O. G. 952, that court has upheld and strongly construed the so-called "ten year proviso."



sideration is, is the mark in use? Has some one else a prior right to it? There is no way at present of answering this question. There is no place where a search can be made that will disclose even any substantial part of the trade-marks in use. The records of the Patent Office do not show one one-hundredth of existing trade-marks. What marks are being used is the important question to be answered *because it is use alone* that creates the right. And this is what I am coming to. It should be recognized that the important thing to know is what trade-marks are being used, how long, upon what goods, where, and by whom? There should be some government department or bureau where this information could be obtained. This should be the purpose of a registration statute. Our present law in this respect is a failure. It should be repealed and in its place there should be enacted a statute creating a trade-mark bureau, preferably in the Department of Commerce. It should be a recording office with no judicial or quasi-judicial functions. There should be no interference, opposition or cancellation proceedings. All trade-marks used in interstate or foreign commerce should be required to be filed in this bureau, with the name and address of the claimant, a statement of the goods on which the mark is used, and the date of first use. The recording fee should be nominal, say two dollars or less. Registration could in a measure be enforced by providing that no action should be maintained in any Federal Court with respect to any trade-mark unless it had been registered. Such a statute would furnish a place where information covering trade-marks in use would readily be accessible.

There is no necessity of providing in such an act, for remedies for infringement. The common law has long furnished relief that is adequate, or if something more drastic is required it would be a simple matter to make goods bearing counterfeited or imitated trade-marks contraband of interstate commerce, provide for their seizure and penalize their shipment. In short, the Food and Drugs Act of June 30, 1906, could be extended to apply to merchandise generally along the lines of the English Merchandise Marks Act, and trade-mark infringement treated as misbranding—as in fact it is. The reasons which have made the marks and labels used in interstate and foreign commerce upon foods and drugs the subject of a Federal penal statute apply equally to the marks and labels used in such commerce, upon merchandise generally. Statutes along the lines suggested would furnish information as to trade-marks in use, which is the only matter of consequence, and would make infringement a misdemeanor as it ought to be. The

only people to suffer would be infringers, who now seek to profit by preying on the trade-marks of more successful traders, and lawyers of a certain type properly classed with trade-mark pirates, who now make a living by fostering the abuses made possible by our present trade-mark registration statute. The infringer, of course, deserves no sympathy—the lawyers who would be hurt by the repeal of the present act may be expected to complain bitterly. In this respect one is reminded of Mr. Vholes.

“‘Repeal this statute, my good sir?’ says Mr. Kenge to a smarting client, ‘repeal it, my dear sir? Never, with my consent. Alter this law, sir, and what will be the effect of your rash proceeding on a class of practitioners very worthily represented, allow me to say to you, by the opposite attorney in the case, Mr. Vholes? Sir, that class of practitioners would be swept from the face of the earth. Now you cannot afford—I would say the social system cannot afford—to lose an order of men like Mr. Vholes. Diligent, persevering, steady, acute in business. My dear sir, I understand your present feelings against the existing state of things, which I grant to be a little hard in your case; but I can never raise my voice for demolition of a class of men like Mr. Vholes.’ The respectability of Mr. Vholes has even been cited with crushing effect before Parliamentary committees, as in the following blue minutes of a distinguished attorney’s evidence. ‘Question (number five hundred and seventeen thousand eight hundred and sixty-nine). If I understand you, these forms of practice indisputably occasion delay? Answer. Yes, some delay. Question. And great expense? Answer. Most assuredly they cannot be gone through for nothing. Question. And unspeakable vexation? Answer. I am not prepared to say that. They have never given me any vexation; quite the contrary. Question. But you think their abolition would damage a class of practitioners? Answer. I have no doubt of it. Question. Can you instance any type of that class? Answer. Yes, I would unhesitatingly mention Mr. Vholes. He would be ruined. Question. Mr. Vholes is considered, in the profession, a respectable man? Answer’—which proved fatal to the inquiry for ten years—‘Mr. Vholes is considered, in the profession, a most respectable man.’”

EDWARD S. ROGERS.